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| 09/662,222 | 09/14/2000 | Rogelio Sosa | NETS:0004 | 2445 |

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EXAMINER

COLBERT, ELLA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3624

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/662,222

Applicant(s)

SOSA ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-29, 31, 32 and 34-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-29, 31, 32, & 34-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-13, 15-29, 31, 32, and 34-48 are pending. Claims 1-3, 5, 7, 8, 13, 15-21, 23-29, 31, 32, 35, 36, 38, 39, and 42 have been amended in this communication filed 10/08/04 entered as Response to Election/Restriction.
2. The Objection to the Abstract has been overcome by the amendment to the Abstract and is hereby withdrawn.
3. The Applicants' change to the title of the invention has been approved.
4. The Election/Restriction rejection has been overcome by Applicant's amendment to the claims and is hereby withdrawn. A new ground(s) of rejection is set forth here below.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-5, 7-29, 31, 32, and 34-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,456,984B1) Demoff et al, hereafter Demoff in view of (US 6,505,171 B1) Cohen et al, hereafter Cohen.

As per claims 1 and 26, Demoff teaches, A method of issuing and transacting charge numbers using an electronic communications network, comprising receiving, by a charge number issuing system, a plurality of valid charge numbers from an issuing bank (col. 3, lines 35-37); storing, by the issuing and transaction system, the plurality of valid, charge numbers (col. 3, lines 37-48); detecting, by the issuing system, a request communications network for a valid charge number (col. 3, lines 34-52); selecting, by the issuing and transaction system, one of the plurality providing, by the issuing system via the electronic communications network, the selected valid charge number in response to the request (col. 3, line 19-col. 4, line 16); and establishing, by the issuing and transaction system a pre-paid cash account for the user (col. 2, lines 19-42).

Demoff failed to teach, detecting, by the issuing and transaction system via a charge

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settlement network, a purchase transaction using the selected valid charge number between the user and a merchant: and authorizing by the issuing and transaction system, the purchase transaction if a cash balance of the prepaid cash account is sufficient for a purchase of the purchase transaction. Cohen teaches, detecting, by the issuing and transaction system via a charge settlement network, a purchase transaction using the selected valid charge number between the user and a merchant (col. 3, lines 31-50 and col. 5, lines 4-22); and authorizing by the issuing and transaction system, the purchase transaction if a cash balance of the prepaid cash account is sufficient for a purchase of the purchase transaction (col. 9, line 6 –col. 10, line 13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to detect, by the issuing and transaction system via a charge settlement network, a purchase transaction using the selected valid charge number between the user and a merchant: and authorizing by the issuing and transaction system, the purchase transaction if a cash balance of the prepaid cash account is sufficient for a purchase of the purchase transaction and to modify in Demoff because such a modification would allow Demoff to have a pre-paid card with a unique identifier with the capability to exchange the card for currency and to transfer funds from a pre-paid card account to a merchant account if the transaction is authorized.

As per claims 2 and 27, Demoff teaches, The method of claim 1, wherein the providing the selected valid charge number by the issuing and transaction system comprises providing the selected valid charge number to the user (col. 5, line 61-col. 6, line 16)

As per claims 3 and 28, Demoff teaches, The method of claim 1, wherein the providing the selected valid charge number by the issuing and transaction system comprises providing the selected valid charge number the user via a telephonic network (col. 5, lines 23-36).

As per claims 4 and 29, Demoff teaches, The method of claim 2, wherein the detecting a request comprises detecting an online purchase transaction between an online merchant and the user via a computer communications network (col. 8, line 49- col. 9, line 5).

As per claim 5, Demoff teaches, The method of claim 1, further comprising: the detecting a request comprises detecting, by the issuing and transaction system, an online purchase transaction between an online merchant and the user via a computer communications network (col. 2, lines 37-40 and fig. 8); and the providing the selected valid charge number by the issuing and transaction system comprises providing the selected valid charge number to the online merchant via the computer communications network (col. 2, lines 9-36).

As per claims 7 and 31, Demoff teaches, The method of claim 1, further comprising: expiring, by the issuing and transaction system, the selected one of the plurality of valid charge numbers employed to consummate the purchase transaction (col. 3, lines 38-58).

As per claims 8 and 32, Demoff teaches, expiring, by the issuing and transaction system, each of the plurality of provided valid charge numbers used to consummate the plurality of purchase transactions (col. 3, lines 48-58). Demoff failed to teach, The

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method of claim 1, further comprising: providing, by the issuing and transaction system, a plurality of provided valid charge numbers via the electronic communications network; and detecting, by the issuing and transaction system, a plurality of provided valid charge numbers used to consummate a corresponding plurality of purchase transactions.

Cohen teaches, The method of claim 1, further comprising: providing, by the issuing and transaction system, a plurality of provided valid charge numbers via the electronic communications network (col. 7, line 43-col. 8, line 17); and detecting, by the issuing and transaction system, a plurality of provided valid charge numbers used to consummate a corresponding plurality of purchase transactions (col. 8, line 49 –col. 9, line 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide, by the issuing and transaction system, a plurality of provided valid charge numbers via the electronic communications network; and detecting, by the issuing and transaction system, a plurality of provided valid charge numbers used to consummate a corresponding plurality of purchase transactions and to modify in Demoff because such a modification would allow Demoff to have a pre-paid account or pre-paid card having unique card identifiers provided in an unactivated format with a global computer providing the primary communication medium between parties which have a presence on the network (communications network).

As per claim 9, Demoff teaches, The method of claim 1, further comprising: clearing, by a merchant, the purchase transaction via a charge settlement network (col. 5, lines 6-31 and fig. 7).

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As per claim 10, Demoff teaches, The method of claim 9, further comprising: settling, by a merchant processor associated with the merchant, the purchase transaction through the charge settlement network (col. 4, lines 39-54).

As per claim 11, Demoff teaches, The method of claim 10, further comprising: deducting, by the merchant processor, a merchant discount for the merchant (col. 4, lines 30-54).

As per claim 12, Demoff teaches, The method of claim 9, further comprising: routing, by a switch network of the charge settlement network, the selected one of the plurality of valid charge numbers to a predetermine processor for the plurality of valid charge numbers (col. 2, lines 37-40, fig. 1, and fig. 8).

As per claim 13, Demoff teaches, The method of claim 12, further comprising: pre-certifying, by an issuing bank, the issuing and transaction system as processor for the plurality of valid charge numbers (col. 3, lines 34-52 and fig. 1); and the routing by the switch network comprising routing the selected one of the plurality of valid charge numbers to the issuing and transaction system (col. 3, lines 19-34 and fig. 1).

As per claims 15 and 34, Demoff teaches, The method of claim I, wherein the authorizing comprises returning, by the issuing and transaction system, authorization information via the charge settlement network (col. 5, lines 32-61 and col. 6, lines 59-61) .

As per claim 16, Demoff teaches, The method of claim 1, further comprising: clearing, by a merchant via a charge settlement network, the selected valid charge number employed to consummate the purchase transaction (col. 4, lines 38-53);

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routing, by the charge settlement network, purchase transaction information including the selected valid charge number to the issuing and transaction system (col. 5, lines 6-43); and processing, by the issuing and transaction system, the purchase transaction information (col. 4, lines 38-51).

As per claim 17, Demoff teaches, The method of claim. 16, wherein the processing by the issuing and transaction system further comprises: verifying, by the issuing and transaction system, a charge number received via the charge settlement network with the selected valid charge number (col. 3, line 52-col. 4, line 16).

As per claims 18, 35, and 36, Demoff teaches, The method of claim 17, further comprising: generating, by the issuing and transaction system, a valid expiration date corresponding to the selected valid charge number (col. 3, lines 34-51); providing, by the issuing and transaction system via the electronic communications network, the corresponding valid expiration date with the selected valid charge number (col. 4, lines 45-51); and the processing by the issuing and transaction system further comprising verifying an expiration date received via the charge settlement network with the corresponding valid expiration date (col. 3, lines 34-41).

As per claim 19, Demoff teaches, The method of claim 16, wherein the processing by the issuing and transaction system further comprises: comparing, by the issuing system, a purchase amount received via the charge settlement network with a corresponding cash balance (col. 3, lines 37-51).

As per claim 20, Demoff teaches, The method of claim 16, further comprising: authorizing and settling, by the issuing and transaction system, the purchase transaction (col. 4, lines 5-16).

As per claim 21, Demoff teaches, The method of claim 16, further comprising: authorizing and settling, by the issuing and transaction system, a plurality of purchase transactions, each associated with a corresponding one of the plurality of valid charge numbers(col. 6, lines 57-63 and fig. 8); and sending, by the issuing and transaction system, a plurality of settled purchase transactions to a sponsoring bank via an automated clearing house (ACH) batch transfer (col. 6, lines 46-52 and fig. 8).

As per claim 22, Demoff failed to teach, The method of claim 21, further comprising: settling, by the sponsoring bank, the plurality of phase transactions. Cohen teaches, settling, by the sponsoring bank, the plurality of phase transactions (col. 9, lines 6-41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to settle by the sponsoring bank, the plurality of phase transactions and to modify in Demoff because such a modification would allow Demoff to have a financial repository for holding and transferring funds associated with a transaction.

As per claims 23 and 38, Demoff teaches, The method of claim 1, further comprising: the detecting a request comprises detecting, by the issuing and transaction system, an online purchase transaction between an online merchant and the user via a computer communications network (col. 2, lines 37-40 and fig. 8); and establishing, by the issuing system, an electronic mail account that enables communication between the

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online merchant and the user via the computer communications network (col. 4, line 55- col. 5, line 5 and figs. 4-6).

As per claims 24, 39, and 40, Demoff teaches, The method of claim 23, further comprising: generating, by the issuing and transaction system, an email address linked to a prepaid cash account associated with the user; and providing; by the issuing system; the email address to the online merchant during the purchase transaction (col.4, lines 30-65 and fig. 6).

As per claims 25 and 41, Demoff failed to teach, The method of claim 1, further comprising: generating, by the issuing and transaction system, a valid expiration date for the selected valid charge number; and providing, by the issuing and transaction system via the electronic communications network, the valid expiration date with the selected valid charge number.

Cohen teaches, The method of claim 1, further comprising: generating, by the issuing and transaction system, a valid expiration date for the selected valid charge number; and providing, by the issuing and transaction system via the electronic communications network, the valid expiration date with the selected valid charge number (col. 3, lines 31-50, col. 9, lines 41-col. 10, line 13 and fig. 6 –shows a timestamp (70) and fig. 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to generate by the by the issuing and transaction system, a valid expiration date for the selected valid charge number; and providing, by the issuing and transaction system via the electronic communications network, the valid expiration date with the selected valid charge number and to modify

in Demoff because such a modification would allow Demoff to have a particular time that the currency contained in the distribution sites is collected and sent to an account.

As per claim 37, Demoff teaches, The charge number issuing system of claim 31, wherein the charge settlement network comprises an electronic funds transfer (EFT) network (col. 6, lines 46-48 and fig. 8).

As per claim 42, Demoff teaches, A charge number issuing and processing system for issuing valid charge numbers via a electronic communications network and for processing the valid charge numbers via a charge settlement network, comprising: an issuing and transaction system, comprising: a storage device that stores a plurality of valid charge numbers issued by an issuing bank (col. 4, lines 17-22); a communication system for coupling to and enabling communications with the electronic communications network (col. 3, lines 19-33 and fig. 1); and a transaction system, coupled to the storage device and the communication system, that detects requests for charge numbers via the electronic communications network and that provides a selected one of the plurality of valid charge numbers via the electronic communications network in response to the request (col. 3, lines 31-48). Demoff failed to teach, a processor system, coupled to the transaction system, for coupling to and enabling communications with the charge settlement network and a switch network, for coupling to the charge settlement network, that routes any of the plurality of valid charge numbers entered into the charge settlement network to the issuing and transaction system for processing. Cohen teaches, a processor system, coupled to the transaction system, for coupling to and enabling communications with the charge settlement

network and a switch network, for coupling to the charge settlement network, that routes any of the plurality of valid charge numbers entered into the charge settlement network to the issuing and transaction system for processing (col. 2, line 66-col. 3, line 30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a processor system, coupled to the transaction system, for coupling to and enabling communications with the charge settlement network and a switch network, for coupling to the charge settlement network, that routes any of the plurality of valid charge numbers entered into the charge settlement network to the issuing and transaction system for processing and to modify in Demoff because such a modification would allow Demoff to have the ability to communicate with a charge settlement network and to route valid charge numbers to the charge settlement network.

As per claim 43, Demoff teaches, The charge number issuing and processing system of claim 42, further comprising: the storage device storing an accounts database including at least one prepaid cash account; and the transaction system configured to authorize a purchase transaction submitted for authorization via the charge settlement network with selected one of the plurality of valid charge numbers if a cash balance in a prepaid cash account is sufficient to cover a purchase amount of the purchase transaction (col. 3, lines 36-40, col. 4, lines 45-51, and fig. 1).

As per claim 44, Demoff teaches, The charge number issuing an processing system of claim 42, further comprising: the storage device. storing an expired charge number database that stores valid charge numbers that have been utilized to consummate a single purchase transaction (col. 3, line 19 –col. 4, line 16).

As per claim 45, Demoff failed to teach, The charge number issuing an processing system of claim 42, further comprising: an electronic mail system, coupled to the transaction system and the storage device, that enables email communication with online merchants that conduct online purchase transactions via the electronic communications network. Cohen teaches, an electronic mail system, coupled to the transaction system and the storage device, that enables email communication with online merchants that conduct online purchase transactions via the electronic communications network (col. 9, lines 65-67, col. 10, lines 1-8, and fig. 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Demoff to include an email feature because it is the easiest way to communicate and the most economical way when conducting transactions electronically.

As per claim 46, Demoff failed to teach, The charge number issuing an processing system of claim 45, wherein the electronic mail system comprises: an email processor, coupled to the transaction system that generates an email addresses; and an email database, stored by the storage device, that stores the generated email addresses. Cohen teaches, wherein the electronic mail system comprises: an email processor, coupled to the transaction system that generates an email addresses; and an email database, stored by the storage device, that stores the generated email addresses (col. 9, lines 65-67, col. 10, lines 1-8, and fig. 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the electronic mail system comprise: an email processor, coupled to the transaction system

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that generates an email addresses; and an email database, stored by the storage device, that stores the generated email addresses and to modify in Demoff because such a modification would allow Demoff to have an e-mail feature because electronic mail is a more economical and easier way of communication when conducting transactions electronically.

As per claim 47, Demoff teaches, The charge number issuing and processing system of claim 42, further comprising: the transaction system generating a valid expiration date to correspond to the selected valid charge number and providing the corresponding valid expiration date with the selected valid charge number via the electronic communications network; and the transaction system configured to authorize a purchase transaction submitted for authorization via the charge settlement network if a charge number received by the processing system is the same as the selected valid charge number and if an expiration date received by the processing system is the same as the corresponding valid expiration date (col. 3, lines 36-40, col. 4, lines 45-51, and fig. 1).

As per claim 48, Demoff teaches, The charge number issuing and processing system of claim 42, wherein the communication system further comprises: a computer network communications system for interfacing a computer communications network; and a telephonic communications system for interfacing a telephonic network (col. 3, line 19 –col. 4, line 32).

Response to Arguments

9. Applicant's arguments filed 10/08/04 have been fully considered but they are not persuasive as addressed above.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cook et al (US 6,675,153) disclosed a method and apparatus for authorizing a transaction between a consumer and a merchant over a network.

Bissonette et al (US 6,343,279) disclosed credit card transactions.

Walker et al (US 6,267,292) disclosed funds and credit line transfers.

Wolff (US 6,247,047) disclosed facilitating computer network transactions.

Wong et al (US 5,956,699) disclosed credit card transactions over the Internet.

Jagadish et al (US 6,105,863) disclosed processing transaction charges.

Kinker et al (US 3,943,335) disclosed automated banking and banking transactions.

"Newsbytes, pN/A; Virtual Mall Opens In Cyperspace 06/20/94" disclosed storing a credit card and setting up an account.

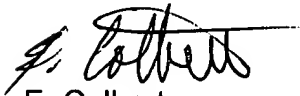
Inquiries

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "E. Colbert", with a stylized flourish extending from the end.

E. Colbert
December 23, 2004